

REMARKS

Interview

Applicants would like to thank Examiner Wang for the phone conference of February 21, 2008. During that conference, Examiner Wang indicated that claims 139-142, 144-154, and 179-183 would be allowable, if a terminal disclaimer were filed. Examiner Wang also indicated that incorporating the elements of claim 96 into claims 93 and 156 would overcome the enablement rejections under 35 U.S.C. § 112, first paragraph.

Applicants would also like to thank Examiner Wang for the phone conference of April 17, 2008. During that conference, Examiner Wang indicated that she is willing to consider amending the claims to recite SV2A or SV2C to overcome the rejection under 35 U.S.C. § 112, first paragraph. Without acquiescing to the propriety of the rejection, Applicants have incorporated the changes suggested by Examiner Wang to place the application in condition for allowance.

Status of the Claims

Claims 93-95, 97-101, 139-141, 144-154, 156, 174-183, and 185-189 are currently pending and under examination. Claims 1-92, 96, 102-138, 142, 143, 155, 157-173, and 184 are canceled without prejudice or disclaimer to the subject matter claimed therein. Applicants respectfully note that claim 143 was canceled in the prior response, but it was not indicated as such in the Office Action Summary.

Amendments to the claims

Claims 93, 139 156, 175, 180, and 186 are amended.

Support for the amendment to claim 93 can be found in canceled claim 96.

Support for the amendments to claims 93, 139, 156, 175, 180, and 186 can be found in claims 102, 142, 175, 180, and 186 as originally filed.

Claim 156 is amended to provide a separate embodiment of the invention.

The amendments to the claims do not add prohibited new matter.

Premature Finality of the Office Action

Applicants respectfully submit that the finality of the Office Action is premature. In response to the last Office Action, Applicants filed an RCE with claim amendments suggested by the Examiner during the phone interview on October 23, 2007, to place the application in condition for allowance. In response, the Examiner issued a Final Office Action alleging that the claims “could have been finally rejected on the grounds and art of record in the next office Action, if they had been entered in the application prior to entry under 37 CFR 1.114.”

Moreover, it appears that the Examiner has introduced a new ground of rejection because the Examiner alleges that claims 93 and 156, directed to a method of identifying a compound that binds a LBS of an SV2 protein, are not enabled by the specification. As mentioned above, the amendments to claims 93 and 156 (to recite “A method of identifying a compound or an agent that binds a LBS of an SV2 protein . . .”) was suggested by the Examiner during the phone interview of October 23, 2007. This enablement issue was not raised in the previous Office Action. Therefore, a new ground of rejection has been introduced. Accordingly, the first Office Action after the submission of an RCE should not be a Final Office Action. Applicants respectfully request withdrawal of the finality of the Office Action.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 93-102, 139-142, 144-154, 156, and 174-189 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable the claimed invention.

The Office Action alleges that the claimed invention, while enabling for identifying a compound that binds SV2, does not provide the limitation that the test compound binds to SV2 in the presence of LEV to determine if the test compound binds to the LBS of SV2.

Without acquiescing to the propriety of the invention, claims 93 and 156 have been amended as suggested by the Examiner to overcome the rejection. This rejection is not applicable to claim 156 because claim 156, as it stands, is enabled for identifying a compound that binds SV2.

The Office Action further alleges that the claims are not enabled for LEV binding to SVB and SVC. The specification describes SV2A, SV2B, and SV2C as isoforms of the SV2 protein family that are all recognized by the same antibody (*see* specification at page 4, lines 9-18).

Moreover, the Office Action acknowledges that LEV binds SV2C based on U.S. Published Patent Application 20050137241 (*see* at Example 21). The Office Action, however, alleges that as this is a post-filing document and may not be used to support the enablement of the claims. It is respectfully submitted that the ability of SV2C to bind LEV is a property of the claimed invention that is verified by the later publication. The claimed invention is directed to methods of identifying agents that compete with LEV binding the LBS of a SV2. The binding of SV2 proteins to LEV and analogs and derivatives thereof at a LBS is an inherent characteristic of the protein. U.S. Published Patent Application 20050137241 is used to confirm that SV2C contains a LBS which is described and enabled in the present application as originally filed. The document also confirms that the presently claimed method of identifying agents that bind a LBS of a SV2 protein is enabled for SV2 isoforms that contain a LBS. Accordingly, the claimed invention of a method of identifying agents that bind a LBS is enabled by both the specification and the later published observations for at least both SV2A and SV2C. It is therefore respectfully requested that this rejection be withdrawn.

Obviousness-Type Non-Statutory Double Patenting

Enclosed is a terminal disclaimer disclaiming the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154, 156, 173, as presently shortened by any terminal disclaimer, of prior U.S. Patent 7,090,985.

Conclusion

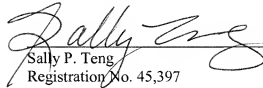
The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments, reconsideration, and the timely allowance of the pending claims. A favorable action is awaited. Should an interview be helpful to further prosecution of this application, the Examiner is invited to telephone the undersigned.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time

under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **May 1, 2008**
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Respectfully submitted,
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